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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,030	08/17/2000	Leanne M. Capozzi	81503F-P	4827

1333 7590 10/09/2003

PATENT LEGAL STAFF
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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,030

Applicant(s)

CAPOZZI ET AL.

Examiner

Mark T Henderson

Art Unit

3722

-- Th MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-23 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 24-50 have been canceled. Claims 1, 5, 6, 15, 20 and 23 have been amended for further examination.

Art Unit: 3722

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al (3,895,220).

Nelson discloses a kit comprising: an order form (12) for ordering goods provided on a plurality of hard copy prints (16a-16d); an instruction form (14) on how to use the kit and having a machine readable code (18) to provide and obtain information; wherein the instructions are on a hard copy document with a visual format; and an envelope holder with a pocket (34).

However, Nelson et al does not disclose a kit for organizing a plurality of images; an instruction form for association with the plurality of hard copy prints; information used in organizing digital images into groups or categories; information for use in organizing the images; a holder for organizing the images ; pockets for organizing the images and for associating the instruction form with the plurality of hard prints.

In regards to **Claims 1, 5, and 6**, a recitation of the intended use (for organizing images) of the claimed invention must result in a structural difference between the claimed invention and

Art Unit: 3722

the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the instruction form, code and holder pockets of Nelson et al are capable of being associated with a plurality of hard copy prints; providing information used in organizing digital images into groups or categories; and for associating the instruction form with the plurality of hard copy prints.

In regards to **Claims 1 and 5**, the images being obtained by scanning does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113).

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many pockets in the envelope as desired for the purpose of holding more items, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Art Unit: 3722

3. Claims 1-14, 16 and 21-23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth (5,547,226) in view of Hicks (5,359,387) and further in view of Johnson et al (5,060,980).

Wentworth discloses in Fig. 1, a kit for organizing comprising various forms (Col. 3, lines 40-46) which can be placed in the kit; a hard copy instruction form document in visual format (as seen in Fig. 2); an envelope holder (12) which can include pockets (Col. 3, lines 51-53); and a container (11) having other sections for holding other formats such as cards.

However, Wentworth does not disclose: a kit for organizing images; an instruction form having a code capable of being machine read so as to obtain information for use in organizing; instructions on how to use the kit; a holder and pocket for organizing images; an instruction associated with a unique order instruction, and information associated with the images; a container for holding images; wherein the code comprises a color for the instruction form; wherein the instruction form is the same size as the hard copy prints; and a tool for use in determining the number of the image to be scanned.

Hicks discloses in Fig. 2, an order form (14) for ordering goods (26), wherein the order can be read by a tool (computer data base and reading device, as stated in Col. 4, lines 5-26).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include an order form as taught by Hicks for the purpose of ordering items desired by the end user.

Art Unit: 3722

However, Wentworth as modified by Hicks does not disclose an instruction form having a code so as to obtain information; instructions on how to use the kit; an instruction associated with a unique instruction, and information associated with the images; a holder and pockets for organizing images; a container for holding images; wherein the code comprises a color for the instruction form; and wherein the instruction form is the same size as the hard copy prints.

Johnson et al discloses in Fig. 1, a form which can comprise instructions (Col. 6, lines 5-8 and 15-18), machine readable code (26) which can be in the form of an icon (Col. 4, lines 62-64), and human readable indicia (12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include an instruction form having encoded indicia as taught by Johnson et al for the purpose of informing the end user.

In regards to **Claims 1, 2, 5, 6, 8, 9, 12-14 and 21**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the kit of Wentworth is capable for organizing a plurality of images.

In regards to **Claim 9 and 10**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desired instructional information, since it

Art Unit: 3722

would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

In regards to **Claim 22**, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431.

In regards to **Claim 23**, it would have been an obvious matter of design choice to construct the instruction form in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

4. Claim 17-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth (5,547,226) in view of Hicks and Johnson et al, and further in view of Kawai et al (6,043,866).

Art Unit: 3722

Wentworth as modified by Johnson et al and Hicks discloses a kit comprising all the elements as claimed in claim 1, and as set forth above.

However, Wentworth does not disclose carrier for holding an imaged sheet for allowing automatic feeding of the image through a scanning device, wherein the carrier comprises an adhesive layer, alignment marks, and a retaining member for securely holding the hard copy prints that are to be scanned.

Kawai et al discloses in Fig. 5, a carrier for holding an imaged sheet (G) for allowing automatic feeding of the image through a scanning device, wherein the carrier comprises and adhesive layer (4), alignment marks (2a) for assisting in positioning, and a retaining member (3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Wentworth's kit to include a carrier form as taught by Kawai et al for the purpose of protecting an original imaged sheet from being ruined by a scanning device.

In regards to **Claim 20**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the retaining member of Wentworth as modified by Kawai et al is capable for securely holding scanned prints.

Art Unit: 3722

Allowable Subject Matter

5. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed on July 18, 2003 have been fully considered but they are not persuasive.

In regards to Applicant's arguments that the prior art does not teach: a kit for organizing a plurality of images; code information used in organizing images; a holder for organizing the hard copy prints, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

In regards to applicant's argument that the prior art does not suggest or teach images obtained by scanning, the examiner submits the images being obtained by scanning does not

Art Unit: 3722

structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3722

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

October 6, 2003



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